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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,310	07/14/2000	Hiroshi Narai	Q60136	8380

7590 08/26/2003

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2100 Pennsylvania Avenue NW  
Washington, DC 20037-3202

EXAMINER
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JOYCE, WILLIAM C

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/617,310

Applicant(s)

NARAI ET AL.

Examiner

William C. Joyce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is in response to the amendment filed May 9, 2003 for the above identified patent application.

#### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Okubo et al. (US Patent 6,113,514).

Okubo et al. discloses a manufacturing procedure for producing a disk for a toroidal continuously variable transmission. Referring to column 2, lines 37-43, Okubo et al. discloses that the size of non-metallic inclusions are known to influence the strength of a material with respect to repeated bending stress. The manufacturing procedure of Okubo et al. prevents non-metallic inclusions of high density from being present within a predetermined distance 1.5b of the traction surface, wherein a high density inclusion is .01mm or larger (for example, see column 5, lines 43-48). Examiner notes that the predetermine distance 1.5b is considered to fall within the limitation .4mm or less.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitamura et al. (US Patent 5,855,531) in view of Japanese Reference 06-287710 ('710).

Mitamura et al. discloses a toroidal continuously variable transmission having an input disc, and output disc, and roller bearings. Mitamura et al. does not disclose the discs or the bearings having the claimed layer formed at .4 mm or less from a surface thereof such that the layer does not contain a non-metallic inclusion having a maximum diameter of 0.115mm or more. The prior art Japanese Reference '710 teaches forming rolling bearings from steel and not having a non-metallic inclusion greater than .008mm. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the transmission of Mitamura et al. with rolling bearings formed from steel and not having a non-metallic inclusion greater than .008mm, as taught by Japanese Reference '710, motivation being to increase the durability of the bearings of the transmission.

### ***Response to Arguments***

Applicant's arguments filed May 9, 2003 have been fully considered but they are not persuasive. Applicants' argument that Okubo et al. does not physically measure the metallic inclusion in the transmission component is not persuasive because the prior art teaches the structural limitations of the apparatus claims. More clearly, the limitation

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"the size of the non-metallic inclusions in said layer is measured in said continuously variable transmission component" has been given limited weight because an apparatus claim must define over the prior art in terms of its structure and not the method from which the apparatus is made. If the invention is in how the transmission component is made, Examiner suggests that applicant pursue claims drawn to the method of making the transmission component. However, if applicant presents method claims, the method claims may be rejected over Okubo et al. in an obvious type rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (703) 305-5114. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

 8/25/03  
William C. Joyce